

IN THE DRAWINGS:

By separate Letter to the Draftsperson, Applicants submit corrected drawings for Figures 1, 2, and 5 which are now labeled as "Prior Art" and include the numeric changes to reference numbers 3 and 5, which are now 3' and 5'.

REMARKS

The foregoing amendments and the following remarks are filed in response to the Office Action dated August 23, 2006. Claims 1-13 are pending the application. Replacement figures 1, 2, 3 and 5 are filed to correct minor informalities. The title is amended and a replacement Abstract is provided to correct minor informalities. The specification is amended to correct minor informalities. Claim 1 is amended to more particularly point out and distinctly claim the subject matter of the invention. The amendments do not add new matter. Thus, applicants respectfully request that the Examiner reconsider the presently pending claims.

The drawings stand objected to under 37 C.F.R. § 1.84(p)(4) and for not labeling Figures 1, 2 and 5 as "Prior Art." Applicants submit corrected drawings to overcome the objections. Further, the specification is amended to reflect the changes in Figures 1, 2, and 5. Applicants submit that the objections are rendered moot.

The Abstract stands objected to for using legal phraseology and for allegedly being confusing. Applicants submit a replacement Abstract to place it in proper form, and submit that the objection is rendered moot.

The title stands objected to for allegedly not being descriptive. Applicants amend the title to be more descriptive and to comply with U.S. patent practice. Applicants submit that the objection to the title is rendered moot.

Claims 1-13 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants amend the claims to address the comments by the Examiner in the Office Action. Thus, claims 1-13 are in proper form, and the indefiniteness rejection should be withdrawn.

Claims 1, 2 and 4-13 stand provisionally rejected under the doctrine of non-statutory obviousness-type double patenting as allegedly being unpatentable over

claims 1, 2, and 4-12 of co-pending Patent Application Serial No. 10/820,041. The Office Action states “although the conflicting claims are not identical, they are not patentably distinct from each other.” Applicants hereby file a terminal disclaimer to overcome the double patenting rejection, and respectfully request that the double patenting rejection be withdrawn.

Claims 1, 2, 6, 7, 11 and 12 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,405,489 (Miura). To anticipate, the cited reference must disclose each and every element of the claimed invention. Applicants respectfully traverse the anticipation rejection. Applicants submit that Miura fails to disclose or suggest each and every element of claims 1 and 2.

Miura relates to a structure for mounting a door weather strip. Referring to Figures 6A-B and 7A-C, Miura concerns the fixing means, or clips 45 and/or double sided adhesive tape 46, of the weather strip, i.e. its mounting base section 16, on the outer peripheral surface of the door. That is, Miura seeks to improve the attachment of the weather strip to the door.

To solve the problem identified in Figures 6 and 7 of Miura, Miura discloses a weather strip having a particular configuration. Referring to Figure 1, the weather strip 11 is intended for a front or a rear door and includes an L shaped upper extrusion molding section 12 and a U shaped lower extrusion molding section 13. These two sections are connected with each other by two front and rear molding sections 14 and 15. Strip 11 is provided with a mounting base section 16 and a hollow seal section 17 protruding therefrom. It is important to note here that the subject invention is concerned with the corner of small radius of curvature of the support, and this would correspond to section 15 of Miura.

Referring to Figure 4, the reference describes that when weather strip section 13 is given a load such as when door 23 is closed, hollow seal section 17 is deformed as

shown by the chain lines. Further, the load acts as a compressive force onto the face of adhesion tape 28. Thus, adhesion tape 28 is not peeled off due to door 23 being shut. Important to note here is that the section of weather strip 13 in Figure 4 corresponds to the straight section shown in Figure 1.

Miura does not relate to deformation of weather strip 11 due to the bending of the same at the corners of support 23 of the vehicle door as a result of the curvature of the support. The weather strip 11 of Miura is already bent in the free state by the form of the molding sections 14 and 15 in order to follow these corners.

In the Office Action, the Examiner contends that Miura teaches the features of the claimed gasket, stating on page 9, "once the gasket has been mounted on its support, the elastically-deformable portion is such that in said corner of the support, its right section is subjected to deformation that occupies an area that lies *substantially within* the area occupied by the right section of the gasket when in the free state." Applicants contend that this is an improper interpretation of the teachings of Miura.

Referring to Figure 4 of Miura, this section of weatherstrip does not even relate to that which conforms to the corner of the support, and Figure 4 cannot be relied upon to support a rejection of claim 1 in its amended state. Section 13 in Figure 4 shows the deformation of the weather strip in relation with straight part of the automobile body 24 of the vehicle. It has nothing to do with the claimed sealing gasket and its relation to the support having a small curvature of radius and the elastically deformable portion that has the defined two cross sections of claim 1, as revised. Therefore, regardless of the structure of section 13, this section of weather strip is not the same as that claimed, i.e., one having an elastically deformed portion with a deformed state due to a corner of the support, and this deformed state occupying an area which is substantially within the area occupied by the elastically deformed portion when not deformed due to contact with the corner, i.e., a free state.

Even if the Examiner were to interpret the section 13 of Figure 4 to be the claimed gasket, the gasket section of Figure 4 still does not meet the claim limitation regarding the areas of the deformed and non-deformed states. In Figure 4 of Miura, hollow seal section 17 deforms as shown by the chain lines. Hollow seal section 17 does not occupy an area which is substantially within the area occupied by the non-deformed cross-section. Instead, section 17 is deformed in a direction away from the non-deformed cross-section to alleviate the possibility of adhesive tape 28 being torn off. Applicants submit that Miura fails to disclose or suggest "said deformed cross-section occupies an area which is substantially within that area occupied by said non-deformed cross-section," as recited in claim 1.

Applicants also submit that the relevant drawing for the sectional view in the corner of the support is Figure 5C, and not Figure 4. Referring to Figure 5C of Miura, the deformed section 15, which is at the support where the radius of curvature is small deforms due to the contact with the body 24, and not because of the support being at one corner having a small radius of curvature. The cross section of deformation in Figure 5C does not meet the limitation of claim 1 regarding the areas of the non-deformed and deformed states.

In light of the failure of Miura to disclose the sealing gasket containing all of the features of claim 1, the rejection based on 35 U.S.C. § 102(b) must be withdrawn.

With regard to claim 2, this claim is separately patentable over Miura. Applicants submit that Miura fails to disclose or suggest a triangularly shaped elastically deformable portion that has the feature of two lateral pillars united with each other by an arch, and forming between them an angle of about 10 degrees to 30 degrees, the angle being defined using two straight lines passing substantially through the middles of the pillars at 2/5ths and 4/5ths of the total height of the gasket measured from its fixing position. As pointed out above, the relevant Figure of Miura is Figure 5C, and

this description of Figure 5C provides no basis for the anticipation rejection. In fact, there is no mention whatsoever of any angle associated with seal section 17, and the Examiner is at best speculating as to the presence of the limitations of claim 2 in the disclosure of Miura.

The Office Action states that the lateral pillars are "not numbered, but shown in figure 4" by Miura. Applicants disagree, and submit that the Office Action fails to satisfy the standard for anticipation in applying Miura. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131. The Office Action does not show in Miura anything that expressly describes the features of claim 2, and does not provide any evidence that these features would be "inherent." Further, despite the Office Action's claim, the lateral pillars allegedly shown by Miura are not readily identifiable. For example, applicants note that the Office Action refers to mounting base section 16 as the fixing portion. If so, then applicants consider mounting faces 20 and 21 to extend from the fixing portion. Mounting faces 20 and 21 are not connected by an arch nor do they form an angle with the range of claim 2.

If mounting base section 16 is the fixing point, then applicants submit that hollow section 18 offsets hollow seal section 17 to show an irregular shape and not a triangular shape. Miura is silent on the issue of a gasket that gives a shape extending from its fixing portion that is substantially triangular. Instead, Miura describes a shape being an irregular pentagon in Figures 3 and 4, and does not disclose or suggest a triangular shape. Further, Miura shows pillars which make a measured angle of at least 45° using the two straight lines at $2/5$ ths and at $4/5$ ths of the total height of the weather strip. Thus, Miura fails to show an angle of about 10° to 30° that results in a substantially triangular shape. For at least these reasons, applicants submit that claim 2 recites subject matter that is not disclosed or suggested from the teachings of Miura,

and the rejection of claim 2 must also be withdrawn. If the Examiner maintains this rejection, the Examiner is called upon to support such any further rejection with objective evidence.

Claims 3, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Miura. Claim 8 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Miura in view of U.S. Patent No. 4,542,610 (Weimar). Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Miura in view of U.S. Patent No. 2,379,193 (Shields). Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Miura in view of U.S. Patent No. 4,620,354 (Hess et al.). Applicants respectfully traverse the obviousness rejections, and submit that the cited references, either alone or in combination, disclose or suggest all the features of the presently pending claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some motivation or suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claimed limitations. MPEP 2143. Applicants submit that the Office Action fails to meet these criteria with regard to claims 3, 4, 5, 8-10 and 13.

Applicants submit that claims 3, 4, 5, 8, 9, 10 and 13 are allowable because they depend directly or indirectly from independent claim 1. Claim 1 is not rendered obvious by the teachings of Miura or the additional cited references listed in the Office Action. If an independent claim is unobvious under 35 U.S.C. § 103(a), then any claim depending therefrom is unobvious. MPEP 2143.03. Thus, claims 3, 4, 5, 8, 9, 10 and 13 are unobvious because claim 1 is unobvious.

Applicants also submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 3. Claim 3 recites “wherein the angle is about 20° between the two pillars of the elastically-deformable portion of the gasket.” In rejecting this claim, the Examiner alleges that it would be obvious to modify Miura and employ an angle of 20° since this is nothing more than an optimization of a result effective variable. While it is normally true that optimizing a known variable does not lend patentable merit to a claim, the variable in question must be a known result effective variable. It is undisputable that Miura fails to disclose or suggest an angle of 20°. In fact, Miura makes no mention whatsoever of controlling the shape of the seal through angles of any sides of the seals or the presence of a triangular support that would have sides of a given angle.

Lacking any recognition of controlling the angles of a seal having a triangular shape, the Examiner has no basis to conclude that control of such an angle is a result effective variable that could be optimized. To the contrary, Miura has no recognition of a triangular shape of a sealing gasket, wherein lateral pillars would be angled at a specific value, and particularly not 20° as set forth in claim 3. Thus, claim 3 is not obvious in light of the teachings of Miura and the rejection based on 35 U.S.C. § 103(a) must be withdrawn.

The other cited references do not disclose or suggest these features missing from Miura, or provide any information from which one skilled in the art could achieve the claimed invention. For at least these reasons, applicants submit that the cited references, either alone or in combination, fail to disclose or suggest all the features of the claimed invention and do not establish a *prima facie* case of obviousness with regard to claim 3. For at least these reasons, applicants respectfully request that the obviousness rejections be withdrawn.

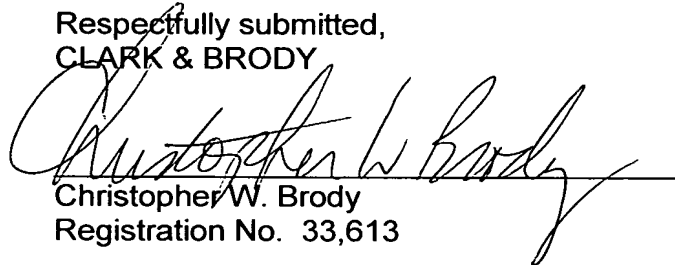
CONCLUSION

In summary, claims 1 and 2 are not anticipated by Miura since this reference fails to teach or suggest the limitations of these claims. Claim 3 is also separately patentable over Miura since the Examiner does not have a legitimate basis to conclude that specifying the angle in claim 3 is an optimization of a known variable. Therefore, these claims along with the remaining dependent claims are allowable over the cited references in view of the amendments and reasons set forth above. A Notice of Allowance to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone or contact the undersigned using the information provided below.

The Office is hereby authorized to charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088 with regard to this application.

Respectfully submitted,
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Attachments:

1. New Abstract
2. Terminal Disclaimer
3. Letter to the Official Draftsperson
4. Corrected Drawings (2 sheets)